

Appl. No. 10/780,024
Response Dated January 4, 2006
Reply to Office Action of August 9, 2005

REMARKS

Claims 1-23 stand in this application. Favorable reconsideration and allowance of the standing claims are respectfully requested.

At page 2, paragraph 2 of the Office Action claims 1, 15, and 22 are rejected under 35 U.S.C. § 112, second paragraph, for not particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. According to the Office Action claims 1 and 22 recite a "sensor" but does not specify "what" is being sensed. A similar statement is made with respect to "detecting" in claim 15. Applicant respectfully traverses the rejection and respectfully requests withdrawal of the indefiniteness rejection based on the following remarks.

Claim 1 recites:

an oscillation circuit to generate an oscillation signal ...
[and] to modify a characteristic of said oscillation signal...

Claim 1 also recites:

a sensor to receive said oscillation signal, detect said
modification, and generate a detect output signal in
accordance with said detection.

Applicant respectfully submits that, according to claim 1, the "sensor" receives the "oscillation signal" and detects the "modification" to the oscillation signal. Further according to claim 1, the "modification" to the oscillation signal is the modification of "a characteristic of said oscillation signal." Therefore, Applicant respectfully submits that claim 1 clearly states "what" is being sensed by the "sensor," namely, the sensor receives the oscillation signal and detects a modified characteristic of the received oscillation signal. Claims 22 and 15 recite features similar to those in claim 1, and for reasons

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analogous to those discussed above with respect to claim 1, Applicant respectfully requests withdrawal of the indefiniteness rejection of claims 1, 15, and 22 under 35 U.S.C. § 112, second paragraph. Applicant further submits that the above arguments are made to overcome a § 112 rejection and are not made to overcome any cited references. Accordingly, these amendments should not be construed to limit the subject matter recited in claims 1, 15, and 22.

At page 2, paragraph 4 of the Office Action claims 1-4 and 20-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Guichard et al. USPN 5,519,317 ("Guichard(1)"). Applicant respectfully traverses the rejection, and requests reconsideration and withdrawal of the obviousness rejection.

The Office Action has failed to meet its burden of establishing a *prima facie* case of obviousness. According to MPEP § 2143, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 706.02(j) and MPEP § 2143 - § 2143.03.

Furthermore, Applicant submits that without motivation to modify the cited reference to arrive at the claimed invention, a rejection based on obviousness under 35

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U.S.C. § 103(a) is improper. *See* MPEP § 2143.01. The motivation to make the alleged modification must be found either in the cited reference or in the knowledge generally available to a person of ordinary skill in the art. *Supra*. Possible sources for motivation to modify the reference may include the knowledge of persons of ordinary skill in the art. The Office, however, cannot rely solely upon the level of skill in the art to provide the suggestion to make the alleged modification of the cited reference to arrive at the claimed subject matter. *Supra*.

Initially, the burden is on the Office to provide some suggestion that it is desirable to do what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *See* MPEP § 2142, for example.

Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness because Guichard(1) fails to disclose every feature recited in claims 1-4 and 20-23 and the Office Action fails to provide a convincing line of reasoning as to why a person of ordinary skill in the art would modify Guichard(1) to arrive at the subject matter recited in claims 1-4 and 20-23. Applicant respectfully submits that the line of reasoning provided in the Office Action is not sufficient to establish a *prima facie* obviousness and, therefore, traverses the rejection, based on the following arguments.

As correctly noted in the Office Action, Guichard(1) fails to disclose "an oscillation circuit to generate an oscillation signal using a marker," as recited in claim 1.

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In addition, Applicant respectfully submits that Guichard(1) also fails to teach or suggest this feature.

Applicant respectfully submits that the Office Action relies on the capabilities of one of ordinary skill in the art to modify the teachings of Guichard(1) to arrive at the subject matter recited in claim 1. Applicant respectfully submits, however, that this line of reasoning is not sufficient by itself to establish a *prima facie* case of obviousness. See MPEP § 2143.01. In the present case, the Office has failed to meet its initial burden to provide some suggestion or motivation that it is desirable to do what the Applicant has done. The Office also has failed to support its conclusion of obviousness by failing to present a convincing line of reasoning as to why a person of ordinary skill in the art would have found the subject matter recited in claim 1 to have been obvious in view of the teachings of Guichard(1).

Rather, the Office Action merely states that it would have been obvious to make the alleged combination and provides a vague and generalized line of reasoning as to why it would have been obvious to a person of ordinary skill in the art to make the alleged modifications to Guichard(1). As discussed previously, a conclusion by the Office that the claimed invention is obvious, either because it is expressly or impliedly suggested in the cited references, must be supported by a convincing line of reasoning setting forth why a person of ordinary skill in the art would have found the claimed invention to have been obvious in view of the teachings of the cited references. See MPEP § 2142, for example.

The line of reasoning provided by the Office is recited at page 3, lines 2-5, where the Office Action states the following unsupported factual assertion:

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Since, marker is a name call for a known type of resonant device or type of a material uses for coil in a resonant circuit. Therefore, it would have been obvious of one having ordinary skill in the art calls resonant circuit is a marker, because performing and result are the same.

Applicant respectfully disagrees and traverses the above factual assertion made in the Office Action including the broad generalized line of reasoning as to why it would have been obvious to modify Guichard(1) to arrive at "an oscillation circuit to generate an oscillation signal using a marker," as recited in claim 1. The Office Action does not set forth a clear line of reasoning or suggestion as to why it would have been desirable for a person of ordinary skill in the art to modify the teachings of Guichard(1) to arrive at the subject matter recited in claim 1 other than "because the performing and result are the same."¹ Therefore, Applicant respectfully requests that the Office produce documentary authority to support the above factual assertion.

Accordingly, Applicant submits that claim 1 is patentable and non-obvious in view of Guichard(1) at least because Guichard(1) fails to disclose, teach or suggest:

an oscillation circuit to generate an oscillation signal using
a marker...

As recited in claim 1.

Furthermore, Applicant submits that claim 1 is patentable and non-obvious in view of Guichard(1) because the Office Action fails to provide documentary authority that teaches or suggests "an oscillation circuit to generate an oscillation signal using a marker" to support the tenuous line of reasoning provided in the Office Action as to why a person of ordinary skill in the art would have found the subject matter recited in claim 1

¹ Without the benefit of a clear line of reasoning as to the motivation to modify the cited reference, Applicant is unable to analyze the merits of the reasoning provided in the Office Action.

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to have been obvious in view of the teachings of Guichard(1). Therefore, Applicant respectfully submits that the Office Action has failed to adequately support its factual assertion that it would have been obvious to one of ordinary skill in the art to modify the sensing part of the selective proximity sensor disclosed in Guichard(1) to arrive at "an oscillation circuit to generate an oscillation signal using a marker," as recited in claim 1.

Guichard(1) provides no suggestion or motivation to use a "marker" in the resonant circuit to generate an oscillation signal. Guichard(1) merely discloses the use of a resonant circuit comprising a coil of inductance L and a capacitor C, but fails to disclose or even suggest using a marker. Furthermore, Applicant submits that it would not have been obvious to a person of ordinary skill in the art to modify the teachings in Guichard(1) and use a marker to generate an oscillation signal in an oscillation circuit. For example, Guichard(1) merely discloses a selective proximity sensor that includes a sensing part including a resonant circuit comprising a coil of inductance L and a capacitor C, where the coil is disposed so that it is affected by a metal object. Guichard(1) at col. 2, lines 48-53. Using a marker to generate an oscillation signal in an oscillation circuit requires a completely different structure than the oscillator and resonant circuit disclosed in Guichard(1).

Claims 15 and 22 recite features similar to those discussed above with respect to claim 1 and for analogous reasons Applicant respectfully submits that claims 15 and 22 are patentable and non-obvious in view of Guichard(1) and the line of reasoning provided in the Office Action. Claims 2-4 depend from claim 1 and contain additional features that further distinguish these claims from the cited reference. Claims 20 and 21 depend from claim 15 and contain additional features that further distinguish these claims from

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the cited reference. Claim 23 depends from claim 22 and contains additional features that further distinguish this claim from the cited reference. Therefore, Applicant respectfully submits that claims 1-4 and 20-23 are patentable.

At page 3, paragraph 5 of the Office Action claims 5-10, 13-14, and 16-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Guichard(1) in view of Guichard et al. USPN 5,508,662 ("Guichard(2)"). Applicant respectfully traverses the rejection, and requests reconsideration and withdrawal of the obviousness rejection.

At page 5, paragraph 6 of the Office Action claims 11-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Guichard(1) in view of Guichard (2) and further in view of Groger et al. USPN 5,514,337 ("Groger"). Applicant respectfully traverses the rejection, and requests reconsideration and withdrawal of the obviousness rejection.

Applicant respectfully submits that if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious. *See* MPEP § 2143.03, for example. Applicant has provided arguments regarding the patentability of claims 1 and 15. Accordingly, removal of the obviousness rejections with respect to claims 5-14, which depend directly or indirectly from claim 1, and claims 16-19, which depend directly or indirectly from claim 15, are respectfully requested.

For at least the reasons discussed above, claims 1-23 are non-obvious and represent patentable subject matter in view of the cited references, whether taken alone or in combination. Accordingly, removal of the obviousness rejection with respect to claims 1-23 is respectfully requested.

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For at least the above reasons, Applicant submits that claims 1-23 recite novel features not shown by the cited references. Further, Applicant submits that the above-recited novel features provide new and unexpected results not recognized by the cited references. Accordingly, Applicant submits that the claims are not anticipated nor rendered obvious in view of the cited references.

Applicant does not otherwise concede, however, the correctness of any rejections with respect to any of the dependent claims discussed above. Applicant hereby reserves the right to make additional arguments as may be necessary to further distinguish the dependent claims from the cited references based on additional features contained in the dependent claims that were not discussed above. A detailed discussion of these differences is believed to be unnecessary at this time in view of the basic differences in the independent claims pointed out above.

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It is believed that claims 1-23 are in allowable form. Accordingly, a timely Notice of Allowance to this effect is earnestly solicited.

The Examiner is invited to contact the undersigned at 724-933-5529 to discuss any matter concerning this application.

Respectfully submitted,

KACVINSKY LLC

/Roberto Capriotti/
Roberto Capriotti, Reg. No. 46,599
Under 37 CFR 1.34(a)

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4500 Brooktree Road
Suite 102
Wexford, PA 15090
(724) 933-5529

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I hereby certify that this correspondence is being transmitted by facsimile on the date shown below to the United States Patent and Trademark Office.

SCHEIDT
Deborah L. Higham

1/4/06
Date